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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,420	07/25/2000	George G. Neuman	P/3458-2	6646

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NEW YORK, NY 100368403

EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,420

Applicant(s)

NEUMAN, GEORGE G.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed on 07/15/03. Claims 1-48 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lavin et al (5,772,585) in view of Kraftson et al (6,151,581).

(A) As per claim 1, Lavin discloses a system to match a consumer of health care services to a health care service provider over a communications network (Col.1, lines 16-67 to Col.2, line 64), the system comprising:

at least one computer terminal associated with the consumer for allowing the consumer access to the communications network (Col.2, lines 1-22; Col.4, lines 33-42);

a network server coupled to the communications network, the server comprising a computer program (Col.4, lines 33-67)having:

a service provider data base identifying a plurality of health care service providers and associated health care service products offered by the service providers (Col.5, lines 36-67 to Col.6, line 67).

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Lavin does not explicitly disclose a first methodology for determining an appropriate treatment based on a. diagnosis provided by the consumer or determined by an alternative diagnosis determiner; and

a second methodology for determining at least one appropriate service provider based on a treatment preference comprising at least one of geographical location of the provider, insurance plan participation, cost, provider experience with the treatment and provider outcome with respect to the treatment.

However, these features are known in the art, as evidenced by Kraftson. In particular, Kraftson suggests a first methodology for determining an appropriate treatment based on a. diagnosis provided by the consumer or determined by an alternative diagnosis determiner (Col.1, lines 13-67 to Col.2, line 50); and

a second methodology for determining at least one appropriate service provider based on a treatment preference comprising at least one of geographical location of the provider, insurance plan participation, cost, provider experience with the treatment and provider outcome with respect to the treatment (Col.1, lines 13-67 to Col.2, line 50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kraftson within the system of Lavin with the motivation of improving patient care, health care, health outcomes, and the management of physician practices (See Kraftson, Abstract lines 12-14).

(B) As per claim 2, Kraftson discloses the system wherein the service provider data base comprises information related to a plurality of service providers, medical products offered by each provider, the provider's experience with each medical product, outcome of each provider

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with respect to each product, price for each product, description of each product and demographic location of each provider (Col.5, lines 7-67 to Col.6, line 67).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(C) As per claim 3, Kraftson discloses the system further wherein the first methodology determines the number of treatment options available for a particular treatment (Col.6, lines 32-67).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(D) As per claim 4, Lavin discloses the system wherein the first methodology determines a selected treatment option if more than one treatment option is available (Col.9, lines 29-67 Col.10, line 30).

(E) As per claim 5, Lavin discloses the system wherein the alternative diagnosis determiner comprises one of a link to a medical diagnosis database and a referral to a physician (Col.13, lines 8-67 to Col.14, line 65)

(F) As per claim 6, Lavin discloses the system wherein the first methodology accesses the service provider database to describe the treatment option when more than one treatment option is available (Col.13, lines 8-67 to Col.14, line 65).

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(G) As per claim 7, Lavin discloses the system wherein the first methodology allows the consumer to obtain a referral to a physician to assist in understanding of treatment options (Col.11, lines 61-67 to Col.12, line64).

(H) As per claim 8, Lavin discloses the system wherein, after the consumer is matched to a service provider, an identification number is issued (Col.7, lines 13-67).

(I) As per claim 9, Lavin discloses the system further comprising a link to the service provider (Col.7, lines 47-67 to Col.8, line 8).

(J) As per claim 10, Kraftson discloses the system further comprising a consumer data base obtained from the second methodology comprising information related to the consumer's choice of service provider (Col.6, lines 1-67).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(K) As per claim 11, Kraftson discloses the system wherein the consumer database is coupled to the service provider data base for updating the service provider data base (Col.6, lines 1-67).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

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(L) As per claim 12, Kraftson discloses the system wherein the second methodology has an input from the service provider data base to determine the at least one appropriate service provider (Col.6, lines 1-67).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(M) As per claim 13, Kraftson discloses the system wherein provider outcome includes an indication of consumer satisfaction (Col.6, lines 1-67 to Col.7, line 42)

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(N) As per claim 14 Kraftson discloses the system further wherein the cost treatment preference includes the capability to offer a reduced cost for greater usage (Col.10, lines 1-67 to Col.11, line 35).

(O) As per claim 15, Kraftson discloses the system further comprising the capability to prioritize the treatment preferences in a selected order (Col.14, lines 6-67 to Col.15, line 43).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(P) As per claim 16, Lavin discloses the system further comprising a program flow for charging the consumer a fee to participate in the system (Col.13, lines 45-59).

(Q) Claim 17 differs from claim 1 by reciting allowing the consumer to access the communications network to connect to a network server coupled to the communications network, the server comprising a computer program having a service provider data base identifying a plurality of health care service providers and associated health care service products offered by the service providers.

As per this limitation, it is noted that Lavin discloses determining an appropriate treatment based on a diagnosis provided by the consumer or determined by an alternative diagnosis determiner (Col.1, lines 16-67 to Col.2, line 64; Col.9, lines 19-67 to Col.10, lines 53) and Kraftson discloses determining at least one appropriate service provider based on a treatment preference comprising at least one of geographical location of the provider, insurance plan participation, cost, provider experience with the treatment and provider outcome with respect to the treatment.

Thus, it is readily apparent that these prior art systems utilize computer program having a service provider database to perform their specified function.

The remainder of claim 17 is rejected for the same reason given above for claim 1, and incorporated herein.

(R) Claims 18-32 recite the underlying process steps of the elements of claims 2-16, and respectively. As the various elements of claims 2-16 have been shown to be either disclosed by or obvious in view of the collective teachings of Lavin and Kraftson, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As

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such, the limitations recited in claims 18-32 are rejected for the same reasons given above for system claims 1-16, and incorporated herein.

(S) Claim 33 differs from claims 1 and 17 by reciting a computer readable storage medium for a program for operating :

As per this limitation, Lavin discloses a system to match a consumer of health care services to a health care service provider over a communication network coupling at least one computer terminal associated with the consumer for allowing the consumer access to the computer network and a network server (Col.2, lines 1-64; Col.4, lines 32-42), the computer readable storage medium comprising a computer program comprising:

a service provider data base identifying a plurality of health care service providers and associated health care service products offered by the service providers (Col.5, lines 36-67 to Col.6, line 67) and Kraftson discloses a first methodology for determining an appropriate treatment based on a diagnosis provided by the consumer or determined by an alternative diagnosis determiner; and a second methodology for determining at least one appropriate service provider based on a treatment preference comprising at least one of geographical location of the provider, insurance plan participation, cost, provider experience with the treatment and provider outcome with respect to the treatment.

Thus, it is readily apparent that these prior art systems utilize computer readable storage program to perform their specified function.

The remainder of claim 33 is rejected for the same reason given above for claims 1 and 17, and incorporated herein.

(T) Claims 34-48 recite the underlying process steps of the elements of claims 2-16, and respectively. As the various elements of claims 2-16 have been shown to be either disclosed by or obvious in view of the collective teachings of Lavin and Kraftson, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 34-48 are rejected for the same reasons given above for system claims 1-16, and incorporated herein.

Response to Arguments

4. Applicant's arguments filed on 7/15/03 regarding claims 1-48 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 7/15/03.

(A) At pages 3-6, of the 7/15/03 response, Applicant makes the following arguments:

(1) The obviousness rejections of claims 1-48 should be withdrawn because the suggested combination of Lavin and Kraftson does not disclose, teach, or suggest each and every feature of the claim.

(2) To establish a prima facie case of obviousness of a claimed invention, the Examiner must show that the suggested combination teaches or suggests all of the claim limitations.

(3) Lavin and Kraftson does not disclose, teach, or suggest a "system comprising:...a service provider data base identifying a plurality of health care service providers and associated health care service products offered by the service providers,

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"and a second methodology for determining at least one appropriate service provider as recited in claim 1.

(4) Kraftson does not discuss or suggest the matching of consumers of health care services to providers of health care service products.

(5) The obviousness rejections of claims 1-48 should be withdrawn because Lavin is a non-analogous art. Lavin is not remotely pertinent to the particular problem with which the present invention is concerned.

(B) With respect to Applicant's first and second arguments, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 3). Note, for example, the motivations explicitly stated at the first full paragraph of page 3 of the previous Office Action. Moreover, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the

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respective reference(s) which specifically support that particular motivation and/or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In addition, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(C) With respect to Applicant's third argument, the Examiner respectfully suggests that Kraftson discloses "the system for data collection improves processing of database information through system performance measurement. The outcomes measurement process tracks the progress of perceived quality of a physician's practice, as well as based on a regional or national comparison. In another embodiment the performance of a physician's effort to improve quality of diagnosis, treatment and are also compared

against the processed information both historically and regionally. In another embodiment, those areas of practice performance identified by processed information which are resistant to improvement efforts by physicians despite being identified are analyzed to improve the information gathering aspects of the machine readable forms” which correspond to Applicant’s claimed feature (See Kraftson, Col.24, lines 5-18). Therefore, Applicant’s argument is not persuasive.

(D) With respect to Applicant’s fourth argument, the Examiner respectfully suggests that Kraftson discloses “ Today, the health care industry focuses on designing programs and products to manage patient problems in a useful, efficient, cost-effective and consumer-oriented manner. Hospital staff members, numerous health care providers and representatives of pharmaceutical research and development industry play an important decision-making role in determining the treatment of disease. However, that role is still ancillary to the patient’s primary care physician who diagnoses the patient problems and provides an individualized treatment regimen” which correspond to Applicant’s claimed feature (See Kraftson, Col. 1, lines 23-67). Therefore Applicant’s argument is not persuasive.

(E) With respect to Applicant’s fifth argument, the Examiner respectfully suggests that Lavin reference is nonanalogous art, it has been held that a prior art reference must either be in the field of Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied

upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the primary reference, Lavin is directed to a relational database including set of data tables associated with the above system and interface. The tables store the information entered by the system user, and the relationships among various tables allows the user to retrieve and manipulate the stored information in a variety of ways. For example, a particular table may point to another table to allow the user to retrieve the data from both tables and analyze the relationship or association between both sets of data. This gives the physician, insurer, or other health care provider the unique ability to examine the efficacy of medical procedures, diagnoses prescriptions, costs or other variables within a particular practice groups (See Lavin, Col.2, lines 52-67), and the secondary reference, Kraftson, is drawn to a system that (1) gathers clinical information (information about the physician's clinical decision-making, including the assessment, therapeutic plan, and health outcomes of that plan); (2) gathers physician /patient information (information about the relationship of the patient to the physician, to the physician's practice and to prescribed therapeutic regimens; (3) gathers practice management/cost information (administrative information; (4) creates a database of this information; (5) analyzes data within the database; and provides selected results of analysis of the information as a report. The data can be analyzed to provide physicians information regarding (A) clinical decisions that have been made and the effectiveness of the treatment regimens prescribed in their practice in comparison with other physicians participating in the system; (B) the perception of quality of the physician's practice and care from the patients' perspective,

including the effects of actions taken by the physician to increase the quality of practice and reactions to the physician's prescribed therapeutic regimens; and (C) the costs and management processes for use in defining the relationship between the physician and the manage care company; and insurance companies" which correspond to Applicant's claimed feature (See Kraftson, Col.5, lines 40-62). Therefore, Applicant's argument is not persuasive.

(F) Moreever, Kraftson is reasonably pertinent to the particular problem with which Applicant was concerned because it is directed to a system and method for acquisition, management and processing of patient clinical information and patient satisfaction information received from a group of physician practices to provide practice performance information, which Applicant indicates is his invention.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 07/15/03 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Lavin and Kraftson, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 3), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches method and apparatus for objectively monitoring and assessing the performance of health-care providers based on the severity of sickness episodes treated by the providers (5,845,254) and delivery of medical services using electronic data communications (5, 619,991).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F
V.F

October 1, 2003


JOSEPH THOMAS
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